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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,145	11/30/2001	Brandon R. Mackay	14591.11	4556

22913 7590 04/23/2004

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER


BRITTAIN, JAMES R

ART UNIT PAPER NUMBER

3677

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,145	Applicant(s) MACKAY ET AL. 	
	Examiner James R. Brittain	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 10-20, 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 8, 21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

A request for continued examination under 37 CFR 1.114 including the fee set forth in 37 CFR 1.17(e) was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2004 has been entered.

Specification Objections

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.175(d)(1) and MPEP §608.01(o). Correction of the following is required: The specification as file fails to provide antecedent basis for the term "kit" (claims 21 and 24-26) and to indicate that grip of the retainer is "frictional" (claim 26).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "kit" (claims 21 and 24-26) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 21 and 24-26 are objected to because of the following informalities: The term "the connector" (claim 21, lines 14, 15; claim 26, line 1) lacks clear antecedent basis since it can refer to either the first or second connector. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 and 24-26 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Upon further review, the use of the term "kit" (line 1 of each of claims 21 and 24-26 and claim 21, line 2) first added to the claims in the amendment received April 25, 2003 lacks written description in the application as filed. While applicant shows the combination of eyeglasses and retainer in the figures and describes them together in the specification, there is no use of the term "kit" and no basis for utilizing this term. It is suggested that applicant utilize the term "combination" so as to overcome this rejection. The modifier "frictionally" as applied to the grip of the connector opening and thereby modifying the type of grip upon the eyeglass temple lacks antecedent basis in the specification as filed and is therefore new matter.

Claim Rejections - 35 USC § 102/103

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Weil (US 2704961).

Weil (figures 7-12) teaches eyeglass retainers comprising a cord 13' having a first end and a second end and first and second connectors 14' coupled to the first end and second ends of the cord 13' wherein the connector has a hollow portion 15 and an opening 23 in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. Weil states in that "The construction is such that tube 14 is engaged over a bulky temple 12 the same as described above." (col. 2, lines 56-57) and this is described by "Each gripper member 14 is a molded tube of rubber or like material having one end of its bore 15 open to receive the end of one of the temples 12. [¶]The bore 15 preferably has a slightly smaller cross section area than the temple 12 so that the latter will fit tightly therein. Further, the bore 15 is made long enough to receive a sufficient length of the temple 12 to ensure enough frictional engagement to prevent accidental disengagement of said temple therefrom." (col. 1, line 76 through col. 2, line 4). Further, the use of the opening 23 is described by "The hole 23, it will be

seen tightly grips the temple 18 and the same is securely fastened to the tube 14” (col. 2, lines 63-65). The connectors are therefore comprised of rubber that is elastic and would be inherently capable of being inserted over the earpiece of less curvature than that of the shown glasses so as to be placed on the temple of the eyeglasses. Since the connectors are made of rubber the openings in the tubular wall are also expandable so as to grip as indicated above.

Claims 21 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Weil (US 2704961) in view of Urwyler (US 6233345).

Weil (figures 7-12) teaches eyeglass retainers comprising a cord 13’ having a first end and a second end and first and second connectors 14’ coupled to the first end and second ends of the cord 13’ wherein the connector has a hollow portion 15 and an opening 23 in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. Weil states in that “The construction is such that tube 14 is engaged over a bulky temple 12 the same as described above.” (col. 2, lines 56-57) and this is described by “Each gripper member 14 is a molded tube of rubber or like material having one end of its bore 15 open to receive the end of one of the temples 12. [¶]The bore 15 preferably has a slightly smaller cross section area than the temple 12 so that the latter will fit tightly therein. Further, the bore 15 is made long enough to receive a sufficient length of the temple 12 to ensure enough frictional engagement to prevent accidental disengagement of said temple therefrom.” (col. 1, line 76 through col. 2, line 4). Further, the use of the opening 23 is described by “The hole 23, it will be seen tightly grips the temple 18 and the same is securely fastened to the tube 14” (col. 2, lines 63-65). The connectors are therefore comprised of rubber that is elastic and would be inherently capable of being inserted over the earpiece of less curvature than that of the shown glasses so as

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to be placed on the temple of the eyeglasses. Since the connectors are made of rubber the openings in the tubular wall are also expandable so as to grip as indicated above. The difference is that the eyeglasses are not shown in combination with the temple extending through the opening 23. However, Urwyler (figure 1) teaches extending the temple of the eyeglasses through the slit 24 so that the temple is secured to the retainer thereby showing that the opening in a hollow member was known to be sized so as to specifically engage in combination the temple of a pair of eyeglasses. As it would be beneficial to improve the versatility of the retainer of Weil so as to be combined with even more types of eyeglasses than the two types shown by Weil, it would have been obvious to combine the retainer with eyeglasses so that the opening receives the temple of the eyeglasses as taught by Urwyler wherein the teaching is that it is desirable to have the combination of retainer and eyeglasses with the retainer has an opening sized to receive the temple of eyeglasses so that the temple and not the earpiece is engaged by the opening in the tubular wall of the hollow member. In regard to claim 26, Weil indicates that the opening 23 tightly grips the temple as shown above and this is sufficient motivation to show the frictional gripping of the temple as claimed with the modification of the teaching of Weil by Urwyler.

Allowable Subject Matter

Claims 1-7, 10-20, 22 and 23 are allowed.

Response to Arguments

Applicant's arguments filed January 20, 2004 have been fully considered but they are not persuasive.

Applicant argues that the retainer of Weil doesn't grip the temple of the eyeglasses. However, Weil states "The hole 23, it will be seen tightly grips the temple 18 and the same is

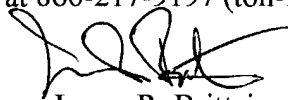
securely fastened to the tube 14'" (col. 2, lines 63-65) and with the tubular member being made of rubber this is sufficient to show the inherent capability of gripping the temple as indicated in the rejection of claim 8 based upon Weil alone and the combination of retainer and eyeglasses as indicated in the rejection of claim 21 based upon Weil in view of Urwyler.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB